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In re Application of	:	
POZZILLI	:	
Application No.: 09/095,639	:	
PCT No.: PCT/EP96/05846	:	DECISION
Int. Filing Date: 27 December 1996	:	
Priority Date: 27 December 1995	:	
Filing Date: 11 June 1998	:	
Attorney's Docket No.: 515-4111	:	
For: PRODUCT DERIVED FROM MILK	:	
SUBSTANTIALLY FREE OF BETA CASEIN FROM	:	
NON-HUMAN MAMMALS AND RELATIVE USE	:	

This application is before the PCT Legal Office for consideration of matters arising under 35 U.S.C. 371.

BACKGROUND

On 27 December 1996, applicant filed international application PCT/EP96/05846, which claimed a priority date of 27 December 1995. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 10 July 1997. A Demand for international preliminary examination, in which the United States was elected, was filed on 16 July 1997, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 27 June 1998.

On 11 June 1998, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*,: a filing fee of \$395.00 and \$82.00 for independent claims in excess of three; a specification (13 pages), sequence listing (4 pages), claims (3 pages), abstract (1 page) and formal drawings (3 pages); a preliminary amendment; and a declaration. The application was processed as a filing under 35 U.S.C. 111(a).

### DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official PTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

\* \* \*

To clearly indicate an international application is being filed under 35 U.S.C. 371 the applicant should use the "Transmittal Letter for United States Designated Office" (Form PTO-1390) as the transmittal letter.

Alternatively, one of the following indications may be used:

1) the applicant shall clearly state in the transmittal or cover letter that he or she is filing under 35 U.S.C. 371 or entering the national stage under PCT; or

2) the applicant clearly identifies in the oath or declaration the specification to which it is directed by referring to a particular international application by PCT Serial Number and International Filing Date and that he or she is executing the declaration as, and seeking a U.S. Patent as, the inventor of the described in the identified international application.

The transmittal letter which accompanied the originally submitted application papers indicates that the application "is being filed under 35 U.S.C. §371". Accordingly, the application will be treated as a national stage application submitted under 35 U.S.C. 371.

As noted above, a specification (13 pages), sequence listing (4 pages), claims (3 pages), abstract (1 page) and formal drawings (3 pages) were submitted on 11 June 1998. However, at least the sequence listing submitted on 11 June 1998 is different than in the international application. Because the application was submitted under 35 U.S.C. 371, the copy of the international application including the three sheets of Annexes accompanying the International Preliminary Examination Report (IPER) will be used.<sup>1</sup> The specification, sequence listing,

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<sup>1</sup>The Annexes (pages stamped "AMENDED SHEETS") are misnumbered. Accordingly, these pages have been renumbered "18-20" rather than as "14-16".

claims, abstract and drawings filed 11 June 1998 have been replaced. In an application filed under 35 U.S.C. 371, amendments are to be made according to 37 CFR 1.121.

Since the application was processed under 35 U.S.C. 111, applicant was charged the basic filing fee of \$395.00. The difference in the filing fee (\$395) and the basic national fee (\$465) where the European Patent Office was the International Searching Authority will be charged to applicant's Deposit Account No. 08-1540.

Applicant is encouraged to use the "Transmittal Letter for United States Designated Office" (Form PTO-1390) as the transmittal letter when submitting papers under 35 U.S.C. 371 for entry into the national stage in the United States.

Also, the declaration filed 11 June 1998 is defective because it executes two different applications: the attached specification and PCT international application PCT/EP96/05846. As noted above, these applications are not identical.

### CONCLUSION

Applicant's claim for priority is acknowledged.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for treatment in accordance with this decision, that is for (1) replacement of the specification, sequence listing, claims, abstract, and formal drawings submitted on 11 June 1998 with the copy of the international application as amended (i.e., the international application as filed but with the original claims being replaced with the Annexes (pages stamped "AMENDED SHEETS" accompanying the IPER); (2) correction of information in PALM (computer database); (3) correction of fees; and (4) preparation and mailing of a NOTIFICATION OF MISSING REQUIREMENTS (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e). The application will be forwarded back to the examiner for continued prosecution of the application after a proper declaration has been submitted and a NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 (Form PCT/DO/EO/903) has been mailed.



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